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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,087	09/25/2003	Scott E. Sampson	51763/3	6319
7590 STOEL RIVES LLP One Utah Center 201 South Main Street, Suite 1100 Salt Lake City, UT 84111				
			EXAMINER	
OYEBISI, OJO O				
ART UNIT		PAPER NUMBER		
3696				
MAIL DATE		DELIVERY MODE		
01/06/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/671,087

**Applicant(s)**

SAMPSON, SCOTT E.

**Examiner**

OJO O. OYEBISI

**Art Unit**

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 and 31-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-28 and 31-43 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

**In the amendment filed on 10/02/08, the following have occurred: claims 1-6, 8, 31, 33 and 40-42 have been amended, and claims 1-28 and 31-43 are currently pending. The examiner contends that the applicant's amendment has introduced new subject matter into the claimed invention, and thus given the claimed invention different scopes and dimensions, necessitating the restriction requirement set forth in this office action.**

#### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-28, 42-43, drawn to a method comprising: an account holder associating a plurality of tokens with a financial account by recording the plurality of tokens in an electronic token log, which electronic token log is accessible by a computing device of an institution that is responsible for authorizing one or more transactions involving the account; and the account holder initiating a transaction involving the financial account by providing one of the tokens previously recorded in the electronic token log and an indication of the account to a vendor, wherein the vendor is to provide the token, the indication of the account, and information about the transaction to the computing device of the authorizing institution, which authorizing institution's computing device provides the vendor with

transaction authorization based on the token being found to exist in the token log, wherein the vendor contact the computing device of the authorizing institution through a communication channel that is distinct from a communication channel by which the plurality of tokens are recorded in the electronic token log, classified in class 705, subclass 35.

- II. Claims 31-39, drawn to an electronic computing system comprising: a token creator to enter and store one or more tokens in a computer memory; a token log to associate in the Computer memory specific tokens with specific conditions under which specific financial transactions will be valid; and a token access sub-system to make one or more tokens available to an account holder for distribution to one or more vendors involved in transactions pertaining to an account of the account holder, wherein each vendor is to provide a specific token, an indication of the account, and information about a transaction to an institution responsible for authorizing one or more transactions involving the account, which institution looks up the Specific token in the token log and authorizes each vendor to complete each vendor's transaction responsive to the specific conditions associated with each specific token in the token log being satisfied, wherein the institution Look-up the specific token in the token log through a communication channel that is distinct from a communication channel by which the institution is provided with the token, the indication of

the account, and information about the transaction, classified in class 705, subclass 44.

- III. Claims 40-41, drawn to an electronic computing system of a financial institution comprising: a communication interface for receiving a token, an indication of an account, and information about a transaction from a vendor, which token was previously stored by an account holder in an electronic token log that is not accessible by a vendor but is accessible by the financial institution; a transaction authorization module for checking whether at least one condition associated with the token in the token log is satisfied; wherein the communication interface is to notify the vendor that the transaction is authorized responsive to the at least one condition being satisfied and wherein the token, the indication of the account, and the information about the transaction are received at the communication interface through a communication channel that is distinct from a communication channel by which the transaction authorization module checks whether the at least one condition associated with the token in the token log is satisfied, classified in class 705, subclass 75.

2. The inventions are distinct, each from the other because of the following reasons
- Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I

relates to a method wherein the vendor contact the computing device of the authorizing institution through a communication channel that is distinct from a communication channel by which the plurality of tokens are recorded in the electronic token log, whereas invention II has a different utility and scope of which institution looks up the Specific token in the token log and authorizes each vendor to complete each vendor's transaction responsive to the specific conditions associated with each specific token in the token log being satisfied, wherein the institution Look-up the specific token in the token log through a communication channel that is distinct from a communication channel by which the institution is provided with the token, the indication of the account, and information about the transaction. Hence invention I has a different utility and scope than invention II.

- Inventions II and III are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II relates to a method wherein institution looks up the Specific token in the token log and authorizes each vendor to complete each vendor's transaction responsive to the specific conditions associated with each specific token in the token log being satisfied, wherein the institution Look-up the specific token in the token log through a communication channel that is distinct from a communication channel by which the institution is provided with the token, the indication of the account, and information about the transaction, whereas invention III has a divergent

scope of wherein the token, the indication of the account, and the information about the transaction are received at the communication interface through a communication channel that is distinct from a communication channel by which the transaction authorization module checks whether the at least one condition associated with the token in the token log is satisfied. Hence invention II has a different utility and scope than invention III.

- Inventions I and III are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to a method wherein the vendor contact the computing device of the authorizing institution through a communication channel that is distinct from a communication channel by which the plurality of tokens are recorded in the electronic token log, whereas invention III has a different utility and scope of wherein the token, the indication of the account, and the information about the transaction are received at the communication interface through a communication channel that is distinct from a communication channel by which the transaction authorization module checks whether the at least one condition associated with the token in the token log is satisfied. Hence invention I has a different utility and scope than invention III. Because these inventions are distinct for the reasons given above and the search required for one Group is not required for another Group, restriction for examination purposes as indicated is proper.

3. Applicants are advised that reply to this requirement to be complete must include

an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OJO O OYEBISI/  
Examiner, Art Unit 3696



**Application Number****Application/Control No.**

10/671,087

**Applicant(s)/Patent under  
Reexamination**

SAMPSON, SCOTT E.

**Examiner**

OJO O. OYEBISI

**Art Unit**

3696